

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re reissue application of:
KANJI KIRIMOTO, et al
Application No.: 10/826,173
Filed: April 16, 2004
For: CABLE DISK BRAKE

Examiner: Thomas J. Williams
Art Unit: 3683

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Commissioner:

This is a reply brief for the above-captioned matter.

With respect to the recapture rejection, contrary to the statements made in the Examiner's Answer, there is no requirement that narrowing features added to a claim must be related to the subject matter amended during prosecution of the original application, and the *Pannu* case cited in the Examiner's Answer is not applicable to the present situation. *Pannu* is a typical recapture case wherein a limiting feature was added to an existing claim element during prosecution of the original patent application, the limiting feature was deleted in the reissue proceeding while retaining the element, and no material narrowing amendment was made to the claim.

Original claim 1 in the *Pannu* patent recited an intraocular lens comprising a lens body, at least two flexible positioning and supporting elements (which the Court referred to as "haptics") integrally formed with the lens body, and a snag resistant means integrally formed on the free ends of the positioning and supporting elements. During prosecution, claim 1 was amended to distinguish over the prior art by reciting the flexible positioning and supporting elements "defining a continuous, substantially circular arc having a diameter greater than the diameter of said lens body, said arc

curved toward said lens circumference.” During the reissue proceeding, the quoted feature added to the flexible positioning and supporting elements was deleted, but the flexible positioning and supporting elements themselves were retained. At the same time, the snag resistant means was amended. Instead of being “substantially greater” than the width of the flexible positioning and supporting elements, the snag resistant means was amended to be “at least three times greater” than the width of the flexible positioning and supporting elements. In addition, the snag resistant means was amended to be “substantially coplanar” with the flexible positioning and supporting elements.

Pannu argued that the modifications to the snag resistant means related to the shape of the haptics (*i.e.*, the flexible positioning and supporting elements). The Court simply noted that, contrary to Pannu’s argument, the narrowing amendments were *not* related to the shape of the haptics and therefore did not affect the shape of the haptics as Pannu alleged. Instead, the narrowing amendments were related to the positioning and dimensions of the snag resistant means. In other words, Pannu’s argument was false. As for the materiality of the narrowing amendment, a comparison of the snag resistant means before and after the amendment clearly shows that the changes were minor, so it is no surprise that the Court concluded that the reissued claims were not narrowed in any material respect. The amended claims were directed to the same invention, with the only difference being a slight modification of the positioning and dimension of the snag resistant means.

The *Pannu* case fits the standard recapture rule. If a claim recites elements A + B + C, and if the claim is amended during prosecution to recite A + B + C + C’, where C’ is a limiting feature of element C, then limiting feature C’ cannot be deleted in a reissue proceeding (while retaining element C) absent some other material narrowing of the claim. However, there is a difference between deleting a limiting *feature* that was added to an element versus deleting the element itself and claiming a separate invention. *Pannu* applies to the former, whereas this case represents the latter. Claim 37 in this case canceled not only feature C’ (the details of the cams), but also element C (the two cams). A new element D (the actuating arm) was added to protect a separate invention A + B + D that was fully disclosed in the originally-filed application. Patentability of such an invention was expressly approved in the *Meyers* and *Murray* cases cited in Appellants’ Appeal Brief.

With respect to the rejections over the prior art, the Examiner's Answer states on page 15 that it is unclear what the relevance is regarding the definitions regarding "removably attached" and "removably secured." Appellants' Brief discussed these terms to show how the suffix "-able" is to be interpreted based on the *Dorel* case cited in the Brief. The Appellants adopted the Court's reasoning and expressly stated the definition of "adjustable" (e.g., claim 37) and "removable" (e.g., claim 73) in the Response to Office Action filed July 9, 2007. When the applicant states the meaning that the claim terms are intended to have, the claims must be examined with that meaning. *In re Zletz* 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed.Cir. 1989).

With regards to claims 38-40, it is believed that Appellants' Brief properly addresses the issues raised.

With regards to claim 43, there is no teaching or reason to modify the length of any bushing in Le Deit, et al to adjust a biasing force of the spring surrounding cable (38).

With regards to claim 47, Carre, et al neither discloses nor provides a motivation to include a cable adjusting bolt fitted within any opening in any cable support associated with "actuating arm (50)."

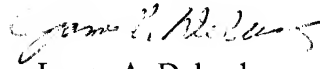
With regards to claims 69 and 72, it is believed that Appellants' Brief properly addresses the issues raised.

With regards to claim 73, Appellants' Brief pointed out how the word "removable" is defined as "designed at some time or another to be removed." "Not removable" means "not designed at some time or another to come apart" (which could be better stated as "not designed to come apart at some time or another") Clearly, Appellants' disclosed support is not designed at some time or another to be removed from the remainder of the caliper housing, and it certainly is not intended to be broken off. The interpretation provided by the examiner is not reasonable.

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Respectfully submitted,

A handwritten signature in cursive script, appearing to read "James A. Deland".

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